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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,746	07/12/2001	Kiyoharu Kishimoto	0152-0572P-SP	9527

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EXAMINER

THAI, LUAN C

ART UNIT PAPER NUMBER

2827

DATE MAILED: 07/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/902,746

Applicant(s)

KISHIMOTO ET AL.

Examiner

Luan Thai

Art Unit

2827

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 12-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Group I claims 1-11 in Paper No. 4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election *without traverse* (MPEP § 818.03(a)).

### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations of "a *Nickel concentration at the reverse surface is higher than a Nickel concentration at the front surface*", as recited in claim 2, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.
4. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, the recitation "*a Nickel concentration at the reverse surface is higher than a Nickel concentration at the front surface*" is unclear. Note that none of drawings shows a nickel layer at the front surface of the electrically conductive layer.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claim 1 and 11 are rejected under U.S.C. 102(e) as being anticipated by Eichelberger et al (6,396,148).

The figures and reference numbers referred to in this office action are used merely to indicate an example of a specific teaching and are not to be taken as limiting.

Regarding claims 1 and 11, Eichelberger et al disclose (specifically see figures 6A-6C and 7A-7C) a semiconductor module comprising: at least one electric element 200 including semiconductor chips csp1/csp2, an electrically conductive layer 209 connected electrically to the electric element 200, an electrically conductive joint 230 arranged between the electric element 200 and the electrically conductive layer 209 to connect electrically the electric element and the conductive layer to each other, a molding resin 215/206 covering partially the electric element and the conductive joint, and an electrically insulating layer 232 contacting at least partially the conductive layer 209.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims **2-10**, insofar as in compliance with 35 USC 112, are rejected under 35 U.S.C. 103(a) as being unpatentable over Eichelberger et al (6,396,148) in view of Wachtler et al (6,274,391).

The figures and reference numbers referred to in this office action are used merely to indicate an example of a specific teaching and are not to be taken as limiting.

Regarding claims 2-3, Eichelberger et al disclose all the limitations of the claimed invention as detailed above except for a nickel layer concentration at a surface of the conductive layer.

Wachtler et al teach the surface of a metallized pad should be plated with nickel in preparation for the solder ball attachment (Col. 10, lines 19+). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Wachtler et al teachings to Eichelberger et al device by forming a nickel layer on a surface of the metal layer 209 faced the bump electrode 234 (e.g., solder) in order to prepare for the solder ball attachment.

Regarding claim 3, Eichelberger et al further disclose the package including second areas of conducting surface positioned on the first outer

substrate layer and connected to a second potential and being different from the first potential (Col. 10, lines 54+ and 65+, Col. 11, lines 1+).

Regarding claims 4-7, the proposed device of Eichelberger et al and Wachtler et al further discloses the insulating layer 232 being juxtaposed with a part of the second layer 209 in a direction perpendicular to a thickness direction of the conductive layer so that surfaces of the insulating layer and the part of the second layer both prevented from facing to the electric element extend along a common flat face.

Regarding claims 8-10, applying Wachtler et al teachings to the device disclosed in Eichelberger et al's figure 2 from which the dielectric layer 112 is considered as the claimed insulating layer, the metallic layer having the nickel plated thereon in the proposed device of Eichelberger et al and Kata et al would have been obvious to extend on a surface of the insulating layer 112 prevented from facing to the electric element 102. Furthermore, it is apparent that nickel is magnetically permeable.

9. The following reference(s) is/are cited as of interest to this application:

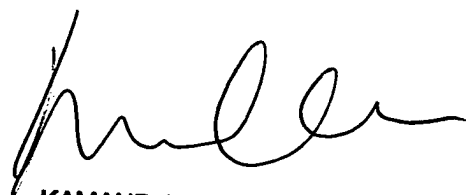
U.S. Pat. No. 5,844,304 to Kata et al is cited for showing a nickel-plating layer being made on an interconnecting layer for the purpose of improving the reliability of the joint between the nickel surface and a bump electrode formed later (Col. 7, lines 4+).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan Thai whose telephone number is (703) 308-1211. The examiner can normally be reached on 7:00 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Talbott can be reached on (703) 305-9883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Luan Thai  
July 1, 2002



**KAMAND CUNEO**  
**PRIMARY EXAMINER**